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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/771,403

02/05/2004

Shinsuke Okada

P24588

3854

7055 7590 10/30/2008  
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EXAMINER

KASZTEJNA, MATTHEW JOHN

ART UNIT

PAPER NUMBER

3739

NOTIFICATION DATE

DELIVERY MODE

10/30/2008

ELECTRONIC

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

gbpatent@gbpatent.com  
pto@gbpatent.com

<b>Office Action Summary</b>	<b>Application No.</b> 10/771,403	<b>Applicant(s)</b> OKADA, SHINSUKE	
	<b>Examiner</b> MATTHEW J. KASZTEJNA	<b>Art Unit</b> 3739	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 07 July 2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1,2 and 6-17 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1,2 and 6-17 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 05 February 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)          | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)          | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____  | 6) <input type="checkbox"/> Other: _____                          |

## **DETAILED ACTION**

### ***Notice of Amendment***

In response to the amendment filed on July 7, 2008, amended claims 1 and 10 and new claims 12-16 are acknowledged. The current rejections of the claims *are withdrawn*. The following new grounds of rejection are set forth:

### ***Claim Objections***

Claim 12 is objected to because of the following informalities: the word "been" appears to be a typographical error in line 2 of the claim. Appropriate correction is required.

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-2 and 6-17 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 5,547,457 to Tsuyuki et al. in view of U.S. Patent No. 3,560,080 to Wilczynski et al.

**In regards to claims 1-2, 6-8 and 10**, Tsuyuki et al. disclose an objective optical system configured to be implemented in a tip of an endoscope, comprising: a first lens unit having a first lens barrel 30 and a first optical system 29 including a plurality of lens L1, L2, L3 elements assembled in said first lens barrel and aligned in a direction of a first common optical axis: and a second lens unit having a second lens barrel 11,

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engageable with the first lens barrel, and a second optical system including a plurality of lens L4, L5 elements aligned in a direction of a second common optical axis, wherein, when the first lens barrel is engaged with the second lens barrel, the lens elements of the first and second lens barrels are aligned along a common axis, the first common axis and the second common axis comprising the common axis (see Figs. 5-6 and col. 8, Lines 18-67). Tsuyuki et al. are silent with respect to the alignment lens being moved by alignment pins in a direction perpendicular to an optical axis thereof. Wilczynski et al. teach of an analogous optical instrument comprising one or more adjustable lens elements and rings, the elements and rings being encased in a cylindrical barrel 33 formed with slots 30, 31, 32 or apertures for a wide range of openings so that lateral and rotative adjustment may be made in all directions to compensate for deficiencies in the manufacture of the separate elements making up the instrument (see Col 2, Lines 47-55). **In regard to claims 12-17**, Fig. 4 illustrates a method of using a flat instrument 68 which may be projected through slot opening 30 in the barrel 33 to push lens II to the right and thus center the lens in a direction perpendicular to the optical axis (see Col. 8, Line 62 – Col. 9, Line 20). It would have been obvious to one skilled in the art at the time the invention was made to modify the apparatus of Tsuyuki et al. to include a plurality of unthreaded holes through which pins may engage and move the alignment lens in a direction perpendicular to the optical axis to provide an inexpensive way of forming a highly corrected lens assembly as taught by Wilczynski et al.

**In regards to claims 9 and 11**, Tsuyuki et al. disclose an objective optical system, wherein the first lens barrel is attached to the second lens barrel by a screw connection (see Figs. 5-6 and Col. 8, Lines 59-64).

***Response to Arguments***

Applicant's arguments with respect to claims 1-2 and 6-17 have been considered but are moot in view of the new ground(s) of rejection.

***Conclusion***

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to **MATTHEW J. KASZTEJNA** whose telephone number is (571)272-6086. The examiner can normally be reached on Mon-Fri, 8:30-6:00.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Linda C.M. Dvorak can be reached on (571) 272-4764. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/M. J. K./  
Examiner, Art Unit 3739

/Linda C Dvorak/  
Supervisory Patent Examiner, Art  
Unit 3739

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